Office Action

Claims 1-25 were rejected under 35 U.S.C. 103(a) as being unpatentable over Arjomand (U.S. Patent No. 5,884,202).

Without conceding the propriety of the rejections independent claim 1 has been amended to include the structural requirement of "said microprocessor, non-volatile storage device, and user interface are integrally connected to said diagnostic tool". Independent claim 21 has also been amended in a generally corresponding fashion. Turning to the prior art reference cited by the Examiner, Arjomand does not teach or fairly suggest at least the features of "said microprocessor, non-volatile storage device, and user interface are integrally connected to said diagnostic tool".

Arjormand, on the other hand, teaches a modular wireless diagnostic test and information system comprised of various independent components. For instance, in FIG. 8 a main control module 12, a digital volt ohm meter 16, a vehicle communication interface 14, an engine analyzer 48, and an interface module 46, are separately and independently utilized to communicate, for instance, to an operator. This teaches away from the claimed invention because the amended claims require an integrally connected structure in order to provide a more compact and portable design for a diagnostic tool utilized by a technician. The cited prior art requires more components for assembly in its completed system in addition to a more substantial incurred cost.

Additionally, Arjomand is silent with respect to updating diagnostic application programs or memory utilized by the tool, as recited in claim 1. At best, Arjomand merely teaches that the firmware may be upgraded by flash reprogramming however, this upgrade is provided only for

the digital volt ohm meter firmware stored in flash memory (see column 8, lines 28-30).

Furthermore, Arjomand teaches away from the claimed invention, because it can not update the

memory of the tool as required, for instance, in claim 1 of the present invention. Arjomand

specifically states the physical memory is not replaced at column 8, lines 31-32. Hence,

Arjomand is not concerned with updating its diagnostic application program or the memory in its

information system. Rather, it's teachings are more directed to enabling users to command

functions of remotely deployed instrumentation modules and to be able to enter data through

interaction with a display as well as execute diagnostic application programs and display

information to the user (*e.g.* see Arjomand's Abstract). Thus, Arjomand's system merely

includes multiple components for a user to interact with preexisting application programs

without the ability to update as claimed, which can provide *e.g.* the ability to upgrade those

programs or add additional storage capacity to its tool.

In accordance with the M.P.E.P. §2143.03, to establish a *prima facie* case of obviousness

of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In*

re: Royka, 490 F2d 981, 180 USPQ 580 (CCPA 1971). "All words in a claim must be

considered in judging the patentability of that claim against the prior art." *In re: Wilson, 424*

F2d 1382, 1385, 165 USPQ 494 196 (CCPA 1970).

The cited prior art, clearly, does not teach or suggest all the claimed features including

"said microprocessor, non-volatile storage device, and user interface are integrally connected to

said diagnostic tool". Since the prior art does not teach or suggest all the claimed features,

withdrawal of the rejection to claim 1 is respectfully requested.

Claims 2-19 depend ultimately from claim 1 and are patentable over the cited prior art for

the same rationale as is claim 1.

Arjomand lacks a teaching of remotely updating diagnostic application programs as claimed by the present invention including the steps of "displaying upgrade procedures after electronic access by a user; determining whether said diagnostic tool is valid for an update; determining whether a valid smart card is present; and providing user notification of the requested upgrade". Since all of the claim limitations are not taught or suggested by the prior art, withdrawal of the rejection is respectfully requested.

Independent claim 21 has been amended in a generally corresponding fashion as was claim 1. Again, the cited prior art does not teach the structural requirements wherein "said executing means, storing means, and updating means are integrally connected to said diagnostic tool". Since the prior art does not teach or suggest all of the claimed features, withdrawal of the rejection is respectfully requested.

Claims 22-25 depend from claim 21 and are patentable over the cited prior art for the same rationale as is claim 21.

In view of the foregoing, reconsideration and allowance of the application are believed in order and such action is earnestly solicited.

Should the Examiner believe that a telephone conference would expedite issuance of the application, the Examiner is respectfully invited to telephone the undersigned Patent Agent at 202-861-1538.

Respectfully submitted,

BAKER & HOSTETLER LLP

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Attachments:
Petition for Extension of Time
Appendix

Date: **November 18, 2002**
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<u>APPENDIX</u>

<u>VERSION WITH MARKINGS SHOWING CHANGES MADE</u>

<u>IN THE CLAIMS</u>

Amended claims 1 and 21.

1.   (Amended) A diagnostic tool for communicating with a vehicular electronic control unit, said diagnostic comprising:

         a microprocessor for executing an operating system and one more diagnostic application programs;

         a non-volatile storage device , in the form of at least one internal and external memory, coupled to said microprocessor; and

         a user interface configured for remote updating of at least one of a diagnostic application program and memory of said tool<u>, wherein said microprocessor, non-volatile storage device, and user interface are integrally connected to said diagnostic tool</u>.

21.   (Amended) A diagnostic tool for communicating with a vehicular electronic control unit, said diagnostic tool comprising:

         means for executing an operating system and one or more diagnostic application programs;

         means for storing diagnostic application programs, said storing means comprising at least one internal and external memory coupled to said means for executing; and

         means for remotely updating at least one of a diagnostic application program and a memory of said tool<u>, wherein said executing means, storing means, and updating means are integrally connected to said diagnostic tool</u>.